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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,946	03/28/2001	D. Wade Walke	LEX-0157-USA	2952

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LEXICON GENETICS INCORPORATED
8800 TECHNOLOGY FOREST PLACE
THE WOODLANDS, TX 77381-1160

EXAMINER

BRANNOCK, MICHAEL T

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 06/03/2003

164

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/819,946

Applicant(s)
Walke et al.

Examiner
Michael Brannock

Art Unit
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 15, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Apr 15, 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

3. ☒ Applicant's reply has overcome the following rejection(s):

See attachment to Advisory Action

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:

See attachment to Advsiory Action

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-3, 6, and 7

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____

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Attachment to Advisory Action

1. The rejection of claim 2 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as set forth previously, is withdrawn in view of Applicant's amendments.
2. Claims 1-3, 6 and 7 stand rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well-established utility, as set forth previously.

Applicant's arguments regarding the utility of GPCRs have been substantially addressed previously and not deemed persuasive. Applicant's arguments regarding due process and comparisons between the instant Application and issued patents have been fully considered but are not persuasive. The examiner is unaware of any requirement that examination of the instant Application for utility and enablement should include any comparison to any published patent. Regarding the promulgation of the current examination guidelines, a Primary Examiner has no authority to comment on the legality of the examination guidelines. Thus, such an issue should be reserved for ruling by the Board of Patent Appeals and Interferences.

Applicant's reference to section (iv) of the previous action seems misplaced, as there is no section (iv). Applicant's arguments regarding "credibility" do not appear to be related to the previous office action. Applicant's arguments regarding the protein as a taste receptor have been substantially addressed previously and not deemed persuasive. Applicant's arguments regarding

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DNA chips and microarrays have been substantially addressed previously and not deemed persuasive. The skilled artisan understands that the specification has merely presented an invitation to use microarray technology to study the expression patterns of the claimed polynucleotide, e.g. to see if the expression changes in response to a drug and to then try to determine if such a change has any meaningful consequence. As set forth previously, such a use does not constitute as specific or otherwise substantial utility.

Applicant's arguments regarding the commercial attractiveness of polynucleotides have been substantially addressed previously and not deemed persuasive. Applicant's arguments regarding the specificity of the chromosomal localization and gene structure of the polynucleotide have been fully considered but not deemed persuasive. As set forth previously, the use of the polynucleotide to map the human genome is not a specific utility in that this use is general to the class of human polynucleotides and that all such polynucleotides have a chromosomal localization. However, such knowledge does not, alone, confer a specific or otherwise substantial utility to the polynucleotide, i.e. such knowledge does not provide an immediate usefulness other than academic investigation.

3. Claims 1-3, 6 and 7 also stand rejected under 35 U.S.C. § 112 first paragraph.

Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention so that it would operate as intended without

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undue experimentation, as set forth previously. It is again noted that the claims require that the polynucleotide encode the full length SEQ ID NO: 2. Applicants' arguments regarding the 35 U.S.C. § 112 rejection as the corollary of the 35 U.S.C. § 101 rejection have been addressed above.

Conclusion


4. No claims are allowable.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB 
May 31, 2003


GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600